

PATENT
Customer No. 22,852
Attorney Docket No. 05725.0636-00000

REMARKS

I. Status of Claims

Claims 1-168 are pending in this application. No claims have been amended or canceled.

II. Rejection Under 35 U. S. C. §103

Narasimhan and Cotteret

Claims 1, 2, 6-31, 40-48, 52-57, 61-86, 95-103, 107-112, 116-141, 150-158, and 162-168 are rejected under 35 U.S.C. § 103 as being unpatentable over U.S. Patent No. 6,315,989 ("Narasimhan") in view of U.S. Patent No. 5,735,908 ("Cotteret"). (*Office Action* at pp. 2-4.)

Applicants respectfully traverse this rejection. The Examiner asserts that Narasimhan teaches all of the claimed ingredients except for the at least one cationic homopolymer comprising the repeating units of formula (I). (*Id.* at pp. 2-3.) To remedy this deficiency, the Examiner relies on Cotteret for disclosing the use of polyquaternium-37. (*Id.* at pp. 3-4.) The Examiner concludes that it would have been obvious to modify the composition of Narasimhan "by incorporating the cationic polymer of polyquaternium 37 as taught by Cotteret ... with a reasonable expectation of success." (*Id.* at p. 4.) To support this conclusion, the Examiner further asserts that Narasimhan suggests the use of cationic polymers and that Cotteret "clearly teaches the polymer of polyquaternium 37 which is structurally similar to those claimed." (*Id.*)

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Applicants respectfully disagree that the references can be so combined. Again, as in the previous Office Actions in this case, the Examiner has engaged in hindsight picking and choosing to arrive at the claimed invention, which is improper.

Selecting the claimed ingredients (b) to (e) from Narasimhan amounts to hindsight picking and choosing

Narasimhan describes a microemulsion peroxide composition comprising, (I) a peroxide composition, and (II) an aqueous alkaline composition. (*Narasimhan* at col. 3, line 1 and col. 9, line 7.) The peroxide composition (I) comprises, (A) an aqueous phase, (B) a continuous oil phase, and (C) an organic surface active ingredient. (*Id.* at col. 3, lines 3-7.) The aqueous alkaline composition comprises "at least one interactive surfactant." (*Id.* at col. 9, lines 9-12.) The dyeing composition is formed by mixing the aqueous alkaline composition with the peroxide composition. (*Id.*)

In the peroxide composition (I), the aqueous phase (A) can comprise:

1. water,
2. **hydrogen peroxide**,
3. optionally penetration enhancers,
4. optionally monohydric alcohols, and
5. "other ingredients"

(*Id.* at col. 3, lines 8-60.)

The continuous oil phase (B) can comprise:

1. volatile oils, which can be chosen from volatile hydrocarbons,
2. nonvolatile oils, which can be chosen from
 - (a) nonvolatile organic oils, which can be chosen from,

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- (i) esters,
- (ii) hydrocarbons,
- (iii) **fatty alcohols**,
- (iv) lanoline and derivatives thereof, and
- (v) other ingredients.

(*Id.* at col. 4, line 61 to col. 5, line 22.)

The organic surface active ingredient (C) can be chosen from:

1. nonionic surface active ingredients, which can be chosen from,
 - (a) **alkoxylated alcohols**, including aliphatic, aromatic, or heterocyclic alcohol with an alkylene oxide ... preferably a **fatty alcohol** having 10-22 carbon atoms
 - (b) sorbitan derivatives,
 - (c) glyceryl ethers
 - (d) glyceryl esters,
 - (e) dialkyl sulfoxides,
 - (f) polyethylene oxide condensates of alkyl phenols,
 - (g) condensation products of ethylene diamine,
 - (h) long chain tertiary amine oxides,
 - (i) long chain tertiary phosphine oxides,
 - (j) polyhydroxy **fatty acid amides**, and
 - (k) alkyl polysaccharides ,
2. anionic surfactants, which can be chosen from,
 - (a) alkyl sulfates,

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- (b) fatty acids esterified with isethionic acid,
- (c) succinates or succinimates,
- (d) olefin sulfonates, and
- (e) N-acyl amino acids.

(Id. at col. 5, line 23 to col. 9, line 5.)

The aqueous alkaline composition can comprise one or more of the following ingredients,

- A. an interactive surfactant, which can be chosen from,
 - 1. amphoteric surfactants,
 - 2. zwitterionic surfactants, and
 - 3. cationic surfactants,
- B. oxidative dye intermediates, which can be chosen from,
 - 1. primary intermediates and couplers
- C. "other ingredients," which can be chosen from
 - 1. penetration enhancers,
 - 2. preservatives,
 - 3. chelating agents,
 - 4. pH adjusters,
 - 5. protein derivatives,
 - 6. plant extracts,
 - 7. oils, and
 - 8. cationic conditioning polymers chosen from
 - (a) quaternary derivatives of cellulose ethers,

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- (b) copolymers of vinylpyrrolidone having a specified monomer unit,
- (c) homopolymer of dimethyldiallylammonium chloride, or copolymer of dimethyldiallylammonium chloride and acrylamide, and
- (d) homopolymers or copolymers derived from acrylic methacrylic acid wherein the monomer units are selected from the group consisting of **acrylamide, methylacrylamide, diacetone-acrylamide, acrylamide or methacrylamide** substituted on the nitrogen by lower alkyl, alkyl esters of acrylic acid and methacrylic acid, vinylpyrrolidone, and vinyl esters.

(*Id.* at col. 9, line 7 to col. 15, line 38.)

The ingredients in boldface indicates the Examiner's citations to support the *prima facie* case of obviousness.

It can be seen that the Examiner had to search through layers of the disclosure to arrive at the claimed invention. The cited prior art provides no direction to choose the claimed ingredients from the lists of numerous possible ingredients and the Examiner has failed to show any motivation to choose and combine the claimed ingredients. The Examiner merely picks the claimed ingredients from thousands of possible combinations and deems it obvious.

Moreover, the examples would lead one of skill in the art away from the claimed combination of ingredients. Example 3 of Narasimhan, cited by the Examiner, as well as Example 5, disclose a composition for oxidative dyeing. These examples do not

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include an alkoxylated fatty alcohol, a fatty amide, or the claimed cationic homopolymer. Thus, three of the five claimed ingredients are missing from the Examples. The remaining examples in Narasimhan omit even more of the claimed ingredients.

Thus, it is clear that based on the large number of possible ingredients disclosed by Narasimhan, the chances of arriving at the claimed ingredients would be very low absent any motivation to do so.

Only with hindsight would one of ordinary skill in the art combine the teachings of Narasimhan and Cotteret

Because Narasimhan fails to disclose the claimed cationic homopolymer, the Examiner turned to Cotteret for disclosing polyquaternium-37.

Again, the specific selection of polyquaternium-37 from Cotteret can only be arrived with hindsight. Cotteret discloses, generally, oxidation dye compositions that include "at least one cationic or amphoteric substantive polymer." (See Cotteret at abstract.) Cotteret devotes two columns to describe exemplary polymers that can be used. However, there is no disclosure in Cotteret, or Narasimhan, that indicates that polyquaternium37 is especially desirable.

The Federal Circuit has repeatedly discouraged such hindsight picking and choosing. For example, a compound containing three components, *i.e.*, a substituted heterocycle, a bridge, and a polar tail, was found to be nonobvious in view of two prior art patents. *Yamanouchi Pharmaceutical Co., Ltd. v. Danbury Pharmacal, Inc.*, 231 F.3d 1339 (Fed. Cir. 2000). Specifically the court found no motivation to combine portions of one compound from a prior art patent with a piece of another compound in a second prior art patent:

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Specifically, Danbury did not show sufficient motivation for one of ordinary skill in the art at the time of invention to take any one of the following steps, let alone the entire complex combination: (1) selecting example 44 as a lead compound, (2) combining the polar tail from example 44 with the substituted heterocycle from tiotidine, and (3) substituting the carbamoyl (CONH₂) group in the intermediate compound with a sulfamoyl group (SO₂NH₂) to create famotidine.

(*Id.* at 1344-1345.)

The Federal Circuit has rejected hindsight reasoning even when the references were agreed by all parties to be in the same field of endeavor as the invention.

Therefore an examiner may often find every element of a claimed invention in the prior art. If identification of each claimed element in the prior art were sufficient to negate patentability, very few patents would ever issue. Furthermore, rejecting patents solely by finding prior art corollaries for the claimed elements would permit an examiner to use the claimed invention itself as a blueprint for piecing together elements in the prior art to defeat the patentability of the claimed invention. Such an approach would be "an illogical and inappropriate process by which to determine patentability."

In re Rouffet, 149 F.3d 135, 1357 (Fed. Cir. 1998) (internal citations omitted). In reversing the rejection, the Federal Circuit required the Examiner to show that one of ordinary skill in the art "with no knowledge of the claimed invention, would select the elements from the cited prior art references for combination in the manner claimed." (*Id.*; emphasis added)

It is clear that the Examiner here has selected the cited references because he had knowledge of the claimed invention. The Examiner provides no rationale for the combination other than that they are "analogous art of hair dyeing composition." The

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Federal Circuit in *Rouffet*, however, has held that this is not enough to support a *prima facie* case of obviousness based on a combination of references.

Accordingly, Applicant respectfully requests withdrawal of this rejection.

Narasimhan, Cotteret, and Casperson

The Examiner has rejected claims 32-39, 49-51, 87-94, 104-106, 142-149, and 159-161 under 35 U.S.C. § 103 as being unpatentable over Narasimhan in view of Cotteret and further in view of U.S. Patent No. 6,156,076 ("Casperson"). (Office Action at pp. 4-6.) Applicants respectfully traverse this rejection.

Applicants respectfully submit that Narasimhan and Cotteret have been improperly combined, as discussed above. Casperson does not remedy this deficiency. Casperson has been relied on for teaching the use of alkoxylated fatty alcohol of laureth-23, and fatty amides of lauramide and cocamide. (Id. at p.5.)

However, Casperson fails to provide any guidance to select the claimed invention set forth in Narasimhan from the wide variety of potential formulations. Again, the Examiner has engaged in hindsight based on the knowledge gleaned from Applicants claims. As discussed above, such hindsight analysis is improper.

Accordingly, Applicants respectfully request withdrawal of this rejection.

III. Conclusion

In view of the foregoing remarks, Applicant respectfully requests reconsideration and reexamination of this application and the timely allowance of the pending claims.

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Please charge the \$110 fee for One-Month Extension of Time and any additional
required fees to our deposit account 06-0916.

Respectfully submitted,

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Dated: September 20, 2004

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